

### **REMARKS**

Claims 1, 3-7, 9-12, 14-18 and 20-29 are pending in this application.

By this Amendment, the specification is amended to correct a typographical error and claims 1, 12, 18 and 26 are amended to more clearly distinguish the invention of the claims over the references cited.

No new matter is added by this Amendment. Support for the language added to the claims is found in the original specification, claims and drawings. In particular, support for the language added to claims 1, 12, 18 and 26 is found at, for example, page 9 of the specification. Thus, no new matter is added by this Amendment.

Applicants appreciate the courtesies shown to Applicants' representatives by Examiner Ghee in the June 7, 2004 telephone conference and by Examiners Ghee and Wallerson in the June 23, 2004 interview. Applicants' separate record of the substance of the interviews are incorporated into the following remarks.

#### **I. Status of Application**

As acknowledged by Examiner Ghee in the June 7 telephone conversation, the current application is under a **NON-FINAL** rejection and **NOT** a final rejection, as indicated in the Office Action. Written confirmation of the status of the application is respectfully requested in the Examiner's next reply.

#### **II. Rejection Under 35 U.S.C. §102(e)**

The Office Action rejects claims 1, 6, 26 and 27 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,012,083 (hereinafter "Savitzky"). The rejection is respectfully traversed.

Applicants' claim 1 is directed to a method for submitting a document in electronic form to a service bureau for printing, including the steps of displaying plural printer routing

options, one of the printer routing options being a service bureau for printing, receiving a print command input to the computer for printing at the service bureau a document stored in memory accessible to the computer wherein the print command includes user individualized instructions, responsive to the print command, routing the document over Internet to the service bureau or an intermediary for printing. The routing step further includes automatically activating a communications program in the computer upon selection of the print command, and transmitting the document to a server associated with the service bureau or the intermediary.

Applicants' claim 26 is directed to a storage medium storing a set of program instructions executable on a data processing device and usable to submit a document in electronic form to a service bureau. The set of program instructions comprise instructions for displaying plural printer routing options, instructions for inputting a selection of one of the plural printer routing options, one of the printer routing options being the Internet print request, instructions for receiving a print command input to the computer for printing at the service bureau a document stored in memory accessible to the computer wherein the print command includes user individualized instructions, instructions for routing the document over the Internet to both the service bureau or an intermediary for printing in response to the print command comprising instructions for automatically activating a communications program in the computer upon selection of the print command, and instructions for transmitting the document to a server associated with the service bureau or the intermediary.

By this configuration, Applicants' invention allows a user to be within any application and send a print job with specific instructions to a service bureau.

In contrast to the present invention, Savitzky is directed to a document retrieval procedure. Specifically, in Savitzky a Web agency is interposed between a Web client and a Web server to transform the requests from the Web client prior to sending the requests on to

the Web server, to transform the document returned from the Web server prior to sending the document on to the Web client, and to store information about the user of various Web clients connected to the Web agency. See the Abstract. The agency 10 is transparent to Web client 12. See col. 5 lines 1-12. Because agency 10 sends and receives HTTP document request and documents, it can interact with Web clients and Web servers which only expect to be communicating with Http Clients or servers. See col. 5, lines 13-23 of Savitzky. More specifically, the agency is transparent to clients or servers which are not aware of the agency and preferably operate transparently between servers and clients even where a client or server is aware of the agency. See col. 3, lines 37-40 of Savitzky.

In other words, Savitzky merely discloses a document retrieval procedure wherein an agency (preferably a transparent agency) serves to translate between clients and servers. For example, as is clearly shown by Figure 5 of Savitzky, Savitzky teaches forwarding a browser display over the Internet to a printer agency which in turn translates the information for printing by a printer.

This is not a teaching of routing a print job to a service bureau over the Internet by activating a communications browser program in the computer and transmitting the document, with print job options, or order form, or user individualized instructions to a server associated with the service bureau.

Further, nowhere does Savitzky teach or suggest a print command including user individualized instructions.

That is, nowhere does Savitzky teach or suggest allowing a user to be within any application and send a print job with specific instructions to a service bureau. More specifically, nowhere does Savitzky teach or suggest submitting a document in electronic form to a service bureau for printing, including at least the step of receiving a print command input to the computer for printing at the service bureau a document stored in memory

accessible to the computer wherein the print command includes user individualized instructions, as required by claim 1.

Further, nowhere does Savitzky teach or suggest instructions for receiving a print command input to the computer for printing at the service bureau a document stored in memory accessible to the computer wherein the print command includes user individualized instructions, as recited by claim 26.

As noted by the Examiner at page 19 of the Office Action, Savitzky discloses "a user might access agency 10 directly, the user typically accesses agency 10 by some action taken with a Web client 12 to access Web server 14." The Patent Office thus concludes that the client 12 can communicate with the Web server 14 in order to access the agency, and therefore Savitzky reads on an intermediary.

In the present invention, a user has a choice of an optional step for transmitting the document associated with the intermediary server. By having this configuration, the intermediary may allow the user to select, for example, from more than one service bureau vendor (e.g., Kinko's and Ikon), and provide vendors with facilities to generate DVDs and CD ROMs. See page 9, lines 21-24 and Fig. 1 of the present application.

Accordingly, Savitzky fails to disclose allowing a user to choose to route the document over Internet to the service bureau or an intermediary for printing, and transmitting the document to a server associated with the service bureau or the intermediary, as recited in claim 1 and similarly recited in claim 26. Instead, Savitzky teaches away from allowing a user to choose how to route the document by requiring that the agency be transparent.

Further, the Office Action alleges that Savitzky discloses a method for "displaying (showing) plural printer routing options (printer locations read on plural printer routing options), one of the printer routing options (printer locations) being a service bureau (printer agency 60 reads on service bureau) for printing (col. 13, lines 15-28)". Although Savitzky

discloses that the printer agency 60 may select a printer by presenting the user with a web page showing printer locations (col. 13, lines 25-28), it is respectfully submitted that Savitzky does not explicitly disclose that one of the printer routing options is a service bureau. In other words, Savitzky discloses that the user selects a printer by merely showing the printer locations, whereas Applicants' claimed invention discloses that one of the printer routing options is a service bureau for printing.

Because Savitzky fails to disclose each and every feature of the claimed invention, it cannot provide a basis for rejection under 35 U.S.C. §102(e). Thus, reconsideration and withdrawal of the rejections are respectfully requested.

**III. Rejection Under 35 U.S.C. §103(a)**

The Office Action rejects claims 23 and 29 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of U.S. Patent Publication No. US 2003/0011806 A1 (Shiohara);

rejects claim 7 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of Shiohara and further in view of U.S. Patent No. 6,134,568 (Tonkin);

rejects claims 3, 5 and 10 under 35 U.S.C. §103(a) as being unpatentable over Savitzky as applied to claim 1 above, in view of Shiohara and further in view of Tonkin;

rejects claim 4 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of Shiohara and Tonkin, and further in view of U.S. Patent No. 6,012,070 (Cheng);

rejects claim 9 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of Cheng;

rejects claim 11 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of U.S. Patent No. 5,524,085 (Bellucco);

rejects claims 12 and 18 under 35 U.S.C. §103(a) as being unpatentable over Tonkin in view of Shiohara and further in view of Savitzky;

rejects claims 15, 16, 21 and 25 under 35 U.S.C. §103(a) as being unpatentable over Tonkin in view of Shiohara, and further in view of Savitzky;

rejects claims 17 and 22 under 35 U.S.C. §103(a) as being unpatentable over Tonkin in view of Shiohara and further in view of Savitzky;

rejects claims 14 and 20 under 35 U.S.C. §103(a) as being unpatentable over Tonkin in view of Shiohara and Savitzky, and further in view of Bellucco; and

rejects claim 28 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of Tonkin.

The rejections are respectfully traversed.

As discussed above, Savitzky neither discloses nor suggests Applicants' claimed invention as found in claims 1 and 26, the independent claims from which rejected claims 3-7, 9-11 and 27-29 depend.

Nor does Tonkin disclose or suggest Applicants' claimed invention as found in claims 12 and 18, the independent claims from which rejected claims 14 -17, 20-22 and 25 depend.

Instead, Tonkin is merely directed to previewing an assembled document. Although Tonkin discloses providing a user interface, this interface requires specific information (i.e., specifying an arrangement of components including pages to be printed, a tab page, a front cover, a back cover, and a binding). See col. 2, lines 41-54 of Tonkin. Nowhere does Tonkin teach or suggest transmission of user individualized print order, as recited in claims 12 and 18.

More specifically, with respect to claims 12, 14-18, 20-22 and 24-25, the cited references of record also fail to similarly disclose or suggest routing the document over Internet to both the service bureau or an intermediary for printing including a fourth module to transmit user individualized print order data and a document to be printed to the server providing the browser with the print order form, as recited in claims 12 and 18.

For at least these reasons, Savitzky, Shiohara, Tonkin, Cheng and Bellucco, either alone or in combination, fail to disclose, teach or even suggest all of the features recited in claims 1, 3-7, 9-12, 14-18 and 20-29. Thus, the various asserted combination of Savitzky, Shiohara, Tonkin, Cheng and Bellucco, fail to disclose or render obvious the subject matter of claims 1, 3-7, 9-12, 14-18 and 20-29. Withdrawal of the rejections of claims 1, 3-7, 9-12, 14-18 and 20-29 based on Savitzky, Shiohara, Tonkin, Cheng and Bellucco and the various asserted combination of these references are respectfully requested.

**IV. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3-7, 9-12, 14-18 and 20-29 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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